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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/463,987 06/05/95 GOICOBCEHA

G END-210

33M1/0816

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EXAMINER  
MILANO, M

ART UNIT PAPER NUMBER

3308

DATE MAILED: 08/16/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 6/5/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.                  |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/>  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1854-61 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1854-61 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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### **Part III DETAILED ACTION**

#### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 and 54-61 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 54-61 of copending application Serial No. 08/461514, 08/462272, 08/463981, 08/463991 and 08/465653. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

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3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 54 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending application Serial No. 08/317,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of broader claim 54 are contained within narrower claim 10 of the '763 application. This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Lazarus (5,397,345). Lazarus teaches the use of an introducer comprising a tubular outer sheath, proximal pusher 31 and distal pusher at 22. Regarding claim 58, the first portion of the lock fitting 101B mates with the second portion of the lock fitting 101A on the cartridge portion 89.

7. Claims 55 and 59 are rejected under 35 U.S.C. § 102(e) as being anticipated by Barone (5,360,443). The Barone graft comprises stents on each end of the graft which are disposed within the blood vessel as claimed and allow blood to flow from the first portion of the stent to the arterial branches.

8. Claims 56 and 57 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Cragg (5,405,377). See column 3, lines 33-50.

9. Claim 59 is rejected under 35 U.S.C. § 102(b) as being anticipated by Ersek (3,657,744). The Ersek graft comprises stents on each end of the graft which are disposed within the blood vessel as claimed.

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10. Claim (59) is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by MacGregor (4,994,071).

11. Claim (59) is rejected under 35 U.S.C. § 102(e) as being anticipated by Chutter (5,387,235). The Chutter graft, as seen in Fig. 47, comprises stents on each end of the graft which are disposed within the blood vessel as claimed.

12. Claims 60 and 61 are rejected under 35 U.S.C. § 102(b) as being anticipated by French Pat. No. 2,678,508 (French '508). Regarding claim 60, the male engaging means of stent 9 "can be compressed" if desired. The use of "can be" does not require the compression of the sent to be a positive limitation in the claim. Regarding claim 61, the end of the first stent 9 is inserted into the end of the second stent and "allowed" to expand. There does not appear to be any compression of the first stent but it is still "allowed" to expand. Merely stating that the stent is allowed to expand does not require the step of compression of the stent.

*Allowable Subject Matter*

13. Claim 54 is allowable over the prior art of record.

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*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication should be directed to Michael Milano at telephone number (703) 308-2496.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 Receptionist whose telephone number is (703) 308-0858.

Milano.mm  
August 09, 1996

  
Michael J. Milano  
Primary Examiner  
Group 3300, AU 3308